

REMARKS

Claims 8-33, 48-49, 51-52, and 71-90 are now pending in this application. The Office Action mailed April 9, 2003, is not precise regarding which claims are rejected over which references for what reasons, but Applicants have assumed herein that each claim rejected in the April 9, 2003 Office Action was rejected for essentially the same reason(s) as in the Office Action mailed October 3, 2002 in this case.

Consequently, Applicants incorporate herein by reference and respectfully repeat the arguments made in the earlier responses filed in this case. In particular, Applicants reiterate that since Stokes merely teaches, at best, streaming securities-related data via a satellite network, Stokes does not teach enabling a user to trade securities over that network (since Stokes does not disclose two-way communications) and Stokes, being directed only to satellite communications, does not teach providing securities information to a user's screen *over the Internet* without the user requesting any updates.

In the October 3, 2002 Office Action (and apparently in the April 9, 2003 Office Action), claims 8-19, 21-29, 31-32, 48-49, 51-52, and 71-80 were rejected under 103(a) as unpatentable over Minton in light of Stokes. Claims 20 and 33 were rejected over Minton and Stokes in light of Tull. Thus, all pending claim rejections rely on Stokes. All claim rejections are respectfully traversed herein.

With this Response, Applicants have included a Declaration under 37 C.F.R. § 1.131, demonstrating that the inventors had conceived and reduced the claimed invention to practice well before December 2, 1998, the 102(a) date of Stokes. Thus, Stokes is not prior art to the subject application.

The Declaration demonstrates that the invention claimed in claim 8, for example, was conceived and reduced to practice at least as early as October 1998. Claim 8 requires "a computer program for providing a computer interface facilitating user-to-user service for users communicating over a network with a computer system." The Declaration states that such a computer program was written by the inventors prior to October 1998.

Claim 8 further requires that the interface comprises: "(a) a computer display of orders to buy certain securities at different prices based on data transmitted over the network by at least some of the users of the service; and (b) a computer display of offers to sell the certain securities at different prices based on data transmitted over the network by at least some of the users of the service." Such a display is shown in Exhibit 2 of the Declaration;

Exhibit 2 is dated October 1998. Moreover, the computer program shown in Exhibit 1 demonstrates that transmission of the order-related information shown in Exhibit 2 had been enabled prior to October 1998.

Finally, claim 8 requires that "at least some displayed data is updated with data transmitted over the network by the computer system without the user requesting any updates." The Declaration, with Exhibits 1 and 2, demonstrates that this element was enabled at least as early as October 1998. The code in Exhibit 1, created prior to October 1998, performs updating of order-related information without the user requesting any updates; the display in Exhibit 2 (especially the comment at the bottom) shows that the data in the display was being so updated at least as early as October 1998.

The Declaration and Exhibits further demonstrate that at least some of the displayed information was updated on a real-time basis and that at least some data transmitted to the user was user-dependent (see, e.g., "Your stks. +87" in the lower left of the display), as required by claims 71 and 81. Thus, Stokes has been successfully "sworn behind," and is not prior art to the subject application.

Since Stokes is not prior art and all claim rejections in the past two Office Actions relied on Stokes, Applicants believe that all rejections have been overcome. Therefore, Applicants respectfully submit that all pending claims are in condition for allowance and request the Patent Office to pass the subject application to issue.

Moreover, Minton does not disclose all of the elements for which it is cited by the Patent Office. For example, Minton does not disclose displaying a list of the user's open orders. The October 2002 Office Action states that Minton discloses such a list at col. 7, lines 33-46. But all that is discussed in that text is displaying offers to buy and sell. There is no mention of a list displaying the user's open orders. Thus, Minton was not properly combined with Stokes to reject claims 16 and 29.

Further, as explained in previous responses in this case (all of which are incorporated herein by reference), the combination of Minton and Stokes, or Minton, Stokes, and Tull, does not result in the claimed invention. For example, as the Patent Office admits at page 11 of the October 2002 Office Action, none of the cited references, either alone or in combination, discloses displaying data relating to a user's positions or account balances being updated in real-time. The mere assertion that a person of ordinary skill in the art would find updating such information in real-time desirable is not sufficient to render claim 74, for

example, unpatentable. The question is not whether such a feature was desirable; the question is whether there was some teaching in the art as to *how to do it*. Applicants improved existing software paradigms that previously had been incapable of providing such individualized securities trading account information to a plurality of users on a real-time basis. Simply put: others may have wanted to do it, but Applicants were the first to do it. Desirability of a feature demonstrates a long-felt need, which weighs against obviousness.

Consequently, the statement by the Patent Office that "it would have been obvious to a person of ordinary skill in the art to incorporate data relating to positions and account balances are updated in real-time into Minton and Stokes so that a trader can see which market maker is buying or selling stock and at what volumes" is not a proper ground for an obviousness rejection. The quoted statement is merely an assertion that such features would be recognized as desirable; it does not demonstrate that the ability to create such features was known. Importantly, however, the quoted statement is also inaccurate, since the account balances and positions being displayed are those of the user viewing the display (i.e., of the "trader") – not of market makers.

More generally, the October 2002 Office Action repeatedly uses the term "obvious" when what is apparently meant is "desirable." For example, at page 3 the Office Action states that "it would have been obvious to a person of ordinary skill in the art to modify the interactive trading system of Minton by including that some data (bids and quotes) are updated on a real-time basis." Applicants respectfully disagree with this and similar statements. Updating such information on a real-time basis was not done by Minton, so it was not obvious to him. If the thought occurred, one of ordinary skill in the art might have felt that providing such a feature was *desirable* but desirability does not render an invention obvious. Indeed, as discussed above, it demonstrates a long-felt need, which strongly weighs against a finding of obviousness.

All claim rejections are therefore believed to have been overcome, and prompt allowance of all pending claims is respectfully requested.

No fee, other than the fee for filing a Request for Continued Examination authorized above, and the three-month extension fee, is believed due with this response. However, if other fees are due, please charge such fees to Pennie & Edmonds LLP's Deposit Account No. 16-1150.

Respectfully submitted,

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